



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: WACHTFOGEL et al. )  
For: ADVANCED TELEVISION SYSTEM )  
Serial No.: 09/515,118 )  
Filed: 24 February 2000 )  
Art Unit: 2623 )  
Primary Examiner: Hai V. TRAN )

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir or Madam:

This is an appeal from the Final Office Action mailed 25 January 2007, finally rejecting all pending claims that had not been withdrawn from consideration. A Notice of Appeal and an after final Amendment accompany this appeal brief. The Amendment cancels all claims except independent claim 132 and its dependent claims 134-36. The claims are cancelled without prejudice in order to narrow the issues for appeal and not for reasons of patentability. Many of those cancelled claims already have been presented in a continuation application, Ser. No. 11/599,216.

The fees for filing the Notice of Appeal and for filing the appellate brief are enclosed. Should there be any deficiency in fees in connection with this Appeal,

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the Commissioner is respectfully requested to and is hereby authorized to charge any deficiency in fees to Deposit Account No. 23-0920.

1. REAL PARTY IN INTEREST.

The real parties in interest are NDS LIMITED and its parent company NDS Group PLC, both companies organized under the laws of England, and both with a place of business at One Heathrow Boulevard, 286 Bath Road, West Drayton, Middlesex UB7 0BQ, United Kingdom.

2. RELATED APPEALS AND INTERFERENCES.

There are no appeals, interferences, or judicial proceedings related to, directly affecting or affected by, or having a bearing on the Board's decision in the captioned Appeal.

3. STATUS OF CLAIMS.

Claims 1-131 and 133 have been cancelled without prejudice. Claims 132 and 134-136 are currently pending, have been finally rejected, and are being appealed.

4. STATUS OF AMENDMENTS.

An after final Amendment accompanying this Appeal cancels, without prejudice, all claims except independent claim 132 and its dependent claims 134-136.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

Independent Claim 132. Claim 132 presents a method of receiving program material (such as by apparatus 10) being broadcast (such as from headend 15), *see e.g.* Figs. 1A and 1B, and dealing with commercials that are at least part of the program material. Dealing with the commercials comprises dealing with at least one of the commercials by presenting alternative shortened versions of other commercials, in response to a user request to view the at least one of the commercials in fast-forward or fast-backward mode. *See e.g.* 32:20-25.

6. GROUNDS OF REJECTION.

Claims 132 and 134-136 stand rejected under 35 U.S.C. §103 as being rendered obvious by Alexander (US 6,177,931) in view of Akiba (US 6,377,745).

7. ARGUMENT - THE COMBINATION OF ALEXANDER AND AKIBA DOES NOT RENDER THE CLAIMS OBVIOUS.

a. Claims 132, 135 and 136

1) **Neither of the Two Cited References Discloses Presenting Other Commercials in Response to a User Request With Respect to the At Least One of the Commercials.**

On page 9 of the Final Office Action, it conceded that Alexander does not disclose the limitation of independent claim 132 that

for at least one of said commercials, said dealing with said commercials comprises dealing with said one commercial by presenting alternative shortened versions of other commercials in response to a user request to view said one commercial in a fast-forward or fast-backward mode.

However, Akiba also does not disclose the missing limitation.

It is very important not to confuse the different terms used in the claim. Being preceded by “said”, the “said one commercial” mentioned twice in the above-quoted limitation necessarily refers to something previously introduced in the claim. What it refers to is the “at least one of said commercials” introduced at the beginning of the above-quoted limitation. On the other hand, the claim term “other commercials” is not preceded by “said” or by “the”, and necessarily refers to something not previously introduced in the claim. The claim term “other commercials” necessarily refers to something different than the **at least one of the commercials** that the user has requested to view in fast-forward or fast-backward mode.

Akiba does not disclose presenting shortened versions of **other** commercials as required by the claims. The Final Office Action suggested that when the Akiba user requests fast-forward for one commercial, that there is a series of commercials coming and that there will be shortened versions of all of them. The Final Office Action characterized this possibility as presenting shortened versions of other commercials. However, Akiba only discloses a fast-forward version of whatever was already there. In addition, Akiba does not disclose a series of commercials (either fast or at normal speed). Assuming *arguendo* there were a series of Akiba fast-forward commercials, those additional fast-forward commercials would **not** be in response to an Akiba user request to view the first commercial in fast-forward. It would be in response to the user continuing in fast-forward mode for the rest of the commercials that would have been presented anyway (albeit more slowly) absent the fast-forward request. Those additional commercials would be among the “at least one of said

commercials" for which the user had requested fast-forward and, therefore, could not be the claimed "other commercials".

On page 2, the Final Office Action stated that an Akiba fast-forward version of a commercial is different than "the non-fast-forward version of the same commercial." [emphasis added]. This may be true, but it is irrelevant. What is relevant is that the Akiba fast-forward version and the Akiba non-fast-forward version are of the same commercial, as conceded by the Final Office Action. The Akiba fast-forward versions are not "shortened versions of other commercials" as presented in claim 132. The claim does not state other (shorter) versions of the same commercials. It states "shortened versions of other commercials" - that is, of different commercials than the ones which the user requested to view in fast-forward or fast-backward mode.

The teaching of Akiba pertains to all video and not to commercials in particular. It teaches some blending from screen to screen to ease eye strain apparently caused by skipping so many screens in a fast-forward mode. (Akiba Abstract; 4:32-37). Akiba also discloses a scheme by which the sampling of screens based on a predetermined interval is delayed and a commercial is skipped entirely, if the commercial is too short relative to the sampling interval. (Akiba 4:61-64; 12:44 – 14:5; Figs. 10 and 11).

Akiba does not teach shortened commercials *per se*, and certainly not short versions of other commercials (i.e., different than the one for which the user requests fast-forward). At most, Akiba discloses a way of presenting a fast-forward version of whatever program the viewer requests to view in fast-forward. If that program is or includes a commercial, then Akiba will present a fast-forward

version of that same commercial (or may skip the commercial entirely if it is too short as mentioned above). For purposes of claim 132, Akiba is effectively no different than any fast-forward presentation.

Therefore, neither Alexander nor Akiba discloses the missing limitation, and the combination of Alexander and Akiba does not render obvious claim 132 or its dependent claims.

**2) There is No Reason To Combine Alexander and Akiba.**

Akiba is about fast-forward/backward in general. As discussed above, its subsidiary discussion about commercials appears to disclose skipping them when they are too short and would interfere with Akiba's purpose of easing eye strain in fast-forward/backward. Akiba does not address a user request to view a commercial in particular in fast-forward/backward, or how to deal with it.

To the extent that Alexander discloses dealing with commercials, it also does not teach about dealing with user requests to view a commercial in fast-forward/backward. In connection with claim 75, the Final Office Action conceded on page 7 that "Alexander does not clearly disclose decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action." While this is broader than the specific way of dealing with commercials presented in claim 132, the concession demonstrated that Alexander also does not address the narrower subject of claim 132.

Therefore, neither of the two references addresses the subject of claim 132. Neither addresses dealing with user requests to view a commercial in fast-forward/backward. Neither reference suggests any reason to look to the other

reference to address a subject with which neither reference is concerned. The Final Office Action used impermissible hindsight, defining a problem and trying to find a solution by using the claimed invention as a roadmap. There cannot be any justification for combining the two references in connection with claim 132, when neither of those references addresses the subject of the claim. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Therefore, the combination of Alexander and Akiba does not render obvious claim 132 or its dependent claims, because there is no justification for combining those two references.

3) Claims 135 and 136 each depends directly or indirectly from independent claim 132.

For the above reasons, the combination of Alexander and Akiba does not render obvious claims 132, 135 or 136.

b. Claim 134

1) **Neither of the Two References Discloses “Prepared Meaningful Shortened Versions”**

Claim 134 depends directly from independent claim 132 and requires the shortened versions of other commercials to comprise “prepared meaningful shortened versions.” As discussed above, Akiba does not disclose the presentation of **other** commercials as used in the claims. Furthermore, Akiba’s fast-forward versions are not prepared meaningful commercials. In Akiba, “the data processor 11 reads out the recorded data from the recording medium 5 at a predetermined interval corresponding to the reproduction speed.” (Akiba, 7:1-3). There is no suggestion of preparing a short commercial that still will be meaningful. Rather, there is merely an automatic selection of screens based on a

predetermined interval, without any preparation and without any consideration of whether an intended message will be conveyed.

The Final Office Action stated on page 10 that an Akiba fast-forward version of a commercial “is meaningful to viewer because not all frames are suppressed,” and similarly on page 3 that “the viewer able to view and enjoy the shortened version” because not all frames of an Akiba fast-forward version of a commercial are suppressed. However, the Final Office Action offered no support for the assertion that the Akiba fast-forward version of a commercial is meaningful because, for example, only 90% of the frames are suppressed. The deficiency of Akiba was unwittingly highlighted by the discussion of claim 136 on page 11 of the Final Office Action. With the benefit of hindsight, the Final Office Action suggested the benefit of presenting a product or a logo for 3 to 5 seconds. That very well may be true, but Akiba does not disclose preparing or presenting such a shortened version of a commercial. Akiba discloses only an automatic selection of screens based on a predetermined interval, without any expectation that those screens will present a recognizable logo, for example, for the duration of the fast-forward version. The Akiba fast-forward version results from automatic screen selection without any consideration of whether an intended message will be conveyed.

Alexander also does not discuss shortened commercials. Therefore, neither of the two references discloses the additional limitation of claim 134, and the combination of Alexander and Akiba does not render obvious claim 134.

2) In addition as discussed above, there is no justification for combining the two references since neither reference addresses the subject of

claim 134. Therefore, the combination of the two references does not render obvious claim 134.

3) Since claim 134 depends from claim 132, the combination of references does not render obvious claim 134 for the reasons presented above with respect to claim 132.

8. CLAIMS APPENDIX.

An appendix is attached containing a copy of the claims involved in this appeal.

9. EVIDENCE APPENDIX.

This appeal does not rely on evidence submitted by appellants.

10. RELATED PROCEEDINGS APPENDIX.

There are no related proceedings.

Favorable consideration of this Appeal and allowance of the captioned application are respectfully requested.

Respectfully submitted,

6 March 2007

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Appellants' Brief on Appeal



## CLAIMS APPENDIX

Claim 132: A method for use with a broadcast system having a headend for broadcasting program material with commercials and a multiplicity of user locations, said method comprising:

receiving said program material being broadcast; and

dealing with said commercials,

wherein, for at least one of said commercials, said dealing with said commercials comprises dealing with said one commercial by presenting alternative shortened versions of other commercials in response to a user request to view said one commercial in a fast-forward or fast-backward mode.

Claim 134: The method according to claim 132 and wherein the alternative shortened versions of other commercials comprise prepared meaningful shortened versions of a full commercial.

Claim 135: The method according to claim 132 and wherein each alternative shortened version has a duration of approximately three seconds.

Claim 136: The method according to claim 135 and wherein each alternative shortened version has a duration of exactly three seconds.